

REMARKS

Claims 1 to 18 were pending in the application at the time of examination. The Examiner objected to the drawings. Claims 1 to 18 stand rejected as obvious.

In view of the objection to the drawings, Applicant has amended the specification to include a description of each of elements 210, 281 and 203 based upon the information in Fig. 2. The amendments to the specification obtain correspondence between the drawings and the specification and do not introduce new matter. Applicant respectfully requests reconsideration and withdrawal of the objection to the drawings.

Applicant also amended the description to correct a grammatical error.

Claims 19 and 20 are new. Claims 19 and 20 are supported at least by the original claims and Fig. 4.

Claims 1 to 5, 7 to 11, and 13 to 17 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,377,354, hereinafter referred to as Nguyen, in view of U.S. Patent No. 5,959,857, hereinafter referred to as Speciner.

The Examiner stated in part:

Nguyen et al does not disclose . . . a transparency list containing the transparent graphics objects of said document page.

Speciner et al disclose a system, wherein objects to be printed are placed in a display list before processing depending on conditions of the object (column 2, lines 28-37).

Nguyen et al and Speciner et al are combinable because they are in the same problem area of printing graphics.

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The motivation to combine the reference is clear because transparent graphics object and other types of non-text objects may need different processing so it is convenient to have a method of separating objects using a list.

Applicant respectfully traverses the obviousness rejection of independent Claims 1, 7, and 13. Applicant notes that the Examiner has failed to cite any teaching or suggestion in Nguyen of differentiating between transparent and non-transparent objects. In fact, the prior art section cited by the Examiner, (Nguyen, Col. 4, lines 40-44) distinguishes between "text" and "bitmap" and so teaches way grouping objects based upon transparency, i.e., teaches away from

creating a transparency list containing the transparent objects . . . (Emphasis Added)

as recited in each of the independent claims.

The Examiner has cited no teaching of determining whether any object in Nguyen is a transparent object. The comparison, according to element 116 in Fig. 3A of Nguyen is whether the object is "text" overlaps a "graphics" and so teaches away from making any distinction based upon transparency of objects. The only consideration is whether the object is text (Element 116 in Fig. 3A), and if yes, does the text overlap a bitmap (Element 122 in Fig. 3A of Nguyen).

In addition, the Examiner has failed to cite any teaching in Speciner of selectively placing objects in a list based upon a characteristic of the object, i.e., creating a transparency list containing the transparent objects. Speciner taught:

The object definition is conditionally added to a display list according to the condition detected. The display list is rendered and cleared when occurrence of the condition is detected.

Speciner, Col. 2, lines 35 to 38.

This is further explained as:

Generally, the conditional display list processor 15 creates a working display list 16 of text and graphic object definitions. Clip objects are stored in memory as indicated at 14 and are referenced by text, image and graphic objects. The display list is referred to as a working display list since it is periodically rendered and cleared, depending upon various conditions as noted above

Speciner, Col. 6, lines 4 to 10.

Thus, the display list of Speciner contains both text and graphic object definitions, and is processed based upon the various conditions. This teaches away from the distinction made between objects in the primary reference and so would require a modification from the way the primary reference works.

Further, Applicant respectfully submits that the Examiner has mischaracterized the teaching of Speciner. The objects are placed in the list and then conditionally processed in view of the above quotation. Selectively rendering and clearing objects in a list fails to suggest or teach creating a particular specific list as recited in the independent claims. Therefore, even if the combination of references were correct, the combination fails to correct the deficiency of the primary reference.

Finally, Applicant respectfully submits that the combination is improper. First, the motivation of "separating objects using a list" fails to explain how the sequential process in Figs. 3A and 3B of Nguyen would be modified and why it is necessary to make such a modification.

Nguyen successfully distinguishes between text and bitmaps without such a list and so there is no need for "separating objects using a list." Second, separating into lists fails to teach or suggest anything concerning what objects are converted into bitmaps. Finally, the Examiner has failed to explain why one of skill in the art would modify the system of Nguyen and incur the overhead associated with storing a list, maintaining

pointers to the list etc. in view of the fact that Nguyen worked successfully for its intended purpose without incurring such overhead.

Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 1, 7 and 13.

Claims 2 to 5 depend from Claim 1 and so distinguish over the combination of reference for at least the same reasons as Claim 1. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 2 to 5.

Claims 8 to 11 depend from Claim 7 and so distinguish over the combination of reference for at least the same reasons as Claim 7. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 8 to 11.

Claims 14 to 17 depend from Claim 13 and so distinguish over the combination of reference for at least the same reasons as Claim 13. Applicant respectfully requests reconsideration and withdrawal of the obviousness rejection of each of Claims 14 to 17.

Claims 6, 12, and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nguyen in view of Speciner and further in view of U.S. Patent No. 5,335,316, hereinafter referred to as Toyokura.

Applicant respectfully traverses the obviousness rejection. Assuming the combination of the three references is proper, the information from Toyokura fails to cure the deficiency of the two primary references. Thus, each of Claims 6, 12, and 18 distinguishes over the combination of references for at least the same reasons as the independent claim from which it depends.

Further, the text cited in Toyokura fails to teach or suggest breaking a frame into subframes. According to

Toyokura, the memory is divided into eight frames, 0 to 7. The Examiner has failed to cite any teaching of further dividing any of the eight frames into subframes. Thus, to arrive at the recited claim language, the teaching of the frames in the reference must be modified into subframes without any explanation in the reference or the rejection on how to do so, or the reason for so doing. The fact that parts of a single character in the reference may be in two different frames does not suggest the concept of a subframe. Applicant requests reconsideration and withdrawal of the obviousness rejection of each of Claims 6, 12, and 18.

Claims 19 and 20 are new. Nguyen teaches away from Claims 19 and 20 by teaching in Fig. 4 that only one word in a plurality of words is extracted and included in the bitmap. Therefore, Claims 19 and 20 distinguish over the combination of references and are in a condition for allowance.

Claims 1 to 20 remain in the application. Claims 19 and 20 are new. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant.

CERTIFICATE OF MAILING

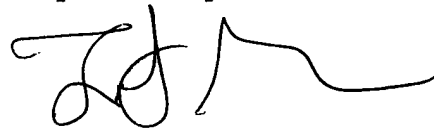
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December 21, 2004
Date of Signature

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